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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
D'AGOSTINO, PAUL ANTHONY	

ART UNIT	PAPER NUMBER
3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/659,581	WADLEIGH, WILLIAM R.	
	Examiner	Art Unit	
	Paul A. D'Agostino	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8,10-18,20-25,27-33,35-39,41-48 and 50-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-18,20-25,27-33,35-39,41-48 and 50-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This responds to Applicant's Arguments/Remarks filed 04/14/2008. Claims 1, 4, 6-7, 10-11, 13-15, 17, 20-21, 24, 27-28, 30, 32, 35-36, 38, 41-42, 44, 47 and 50-51 are amended. Claims 9, 19, 26, 34, 40 and 49 stand cancelled. Claims 53-58 are newly added. Thus, Claims 1-8, 10-18, 20-25, 27-33, 35-39, 41-48 and 50-58 are now pending in this application.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/2008 has been entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887,225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438,.164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321 (d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8, 10-18, 20- 25, 27-33, 35-39, 41-48 and 50-58 are rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-28 of U.S. Patent No. 6,517,433 to Loose et al. (Loose). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards a gaming system that has a video overlay of the reel symbols that when triggered shows a video presentation overlaying the symbols using a motion like video or animation. Loose teaches all of the claimed invention including an

overlay of game symbols that interact with the reel symbols, and of a video display triggered by a bonus condition or type of symbol. Applicant has further amended the claims to include "displaying including overlaying in a video memory storing video data." Loose discloses a bonus game of Fig. 7 which includes a new set of video bonus reels in video image 18 (Col. 4 Lines 40-67). Further, "[t]he bonus game may depict one or more animated events and award bonuses based on an outcome, of animated events" wherein the each of the video reel symbols of Fig. 7 remains visible while a supplemental graphical element is displayed. It would require only routine skill in the art to display the underlying and overlying images from a memory storing video data of both images to conserve memory and increase speed of game play.

Claim Rejections - 35 USC § 102(e)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 10-13, 17-18, 20- 25, 27-33, 35-39, 41-48, and 50-58 rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,517,433 to Loose et al. (Loose) of record.

In Reference to Claims 1, 4, 7, 13, 17, 24, 32, 38, 44, and 47

Loose discloses a system displaying multiple images with a triggering event activating a bonus game in a wagering game (Fig. 7 and Col. 4 Lines 28-40) wherein each of the at least one symbol element remains at least partially visible while the supplemental graphical element is displayed (Fig. 7) to display a video event overlaying the elements (Fig. 7 and Col. 2, 25-33, Col. 4, 58-67, and Col. 5, 52-67) and method comprising:

displaying on a video display a supplemental graphical element over at least one symbol element in one or more displayed reels of a casino gaming machine (Fig. 7 wherein Loose discloses a bonus game which includes a new set of video bonus reels in video image 18 Col. 4 Lines 40-67), the displaying including overlaying in a memory storing video data pixel values of the at least one symbol element with pixel values of the supplemental graphical element (Loose discloses a memory structure of Fig. 11 that can be "several alternative types of memory structure or maybe implemented on a single memory structure Col. 5 Lines 52-66), wherein each of the at least one symbol element that is overlaid remains at least partially visible while the supplemental graphical element is displayed (Fig. 7).

In Reference to Claims 2, 5 and 45

Loose discloses displaying the at least one symbol element; determining, based on the at least one symbol element, whether a triggering event has occurred; and if a

triggering event has occurred, identifying the supplemental graphical element as a set of video images (Col. 4 Lines 58-67).

In Reference to Claims 3, 6, 8, 18, 25, 33, 39, 46, and 48

Loose discloses a method wherein displaying the supplemental graphical element comprises displaying the supplemental graphical element in a manner that creates an appearance of full motion video (Col. 4 Lines 58-67).

In Reference to Claims 10-11, 20-21, 27-28, 35-36, 41-42, and 50-51

Loose discloses an apparatus wherein the one or more processors causes the set of video images to be displayed by causing the set of video images to be displayed in a manner that the set of video images appears as an opaque and semi transparent overlay over each of the one or more of the multiple game element images that are overlaid (Col. 5 Lines 23-30).

In Reference to Claims 12, 22, 29, 37, 43, and 52

Loose discloses an apparatus wherein the one or more processors further: determines whether a video image is associated with an alteration of a game element image within a game element area; and if the video image is associated with the alteration, causes an altered image to be displayed in the game element area (Col. 4 Lines 58-67 and Col. 5 Lines 1-10).

In Reference to Claim 23

Loose discloses an apparatus further comprising a money/credit input/output (I/O) device for enabling a player to obtain credits; and player input devices that enable the player to specify a bet and to initiate a spin of the multiple reels (Col. 3 Lines 26-41).

In Reference to Claims 30-31

Loose discloses a method wherein the electronic game is a game designed for execution on a wagering game machine, and causing the set of video images to be displayed comprises causing the set of video images to be displayed on a display device coupled to the wagering game machine (Col. 1 Lines 40-54).

In Reference to Claims 53-58

Loose teaches of a computer-readable medium and processing which displays supplemental graphical elements to include displaying supplemental graphical elements within a boundary determined by a component of the supplemental graphical elements. (For example, Fig. 6 "explosions" and Fig. 7 "gift boxes" both demonstrate the boundary components of the images wherein where there is not a boundary, the underlying image is revealed).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,517,433 to Loose et al. (Loose) of record in view of U.S. Patent No. 6,375,570 to Poole (Poole) of record.

Loose discloses a system substantially equivalent to Applicant's claimed invention. However, Loose does not teach the apparatus on a portable video game

system, a personal computer, and a video game system using a television set. Poole teaches of a display overlay over certain symbols resulting from a triggering condition on a portable video game system, a personal computer, and of a video game system using a television set (Col. 4 Lines 35-42) with full motion video (Col. 2 Lines 15-30) in order to create greater player entertainment and excitement.

It would have been obvious to one of ordinary skill in the art at the time of invention to employ the portable video game system, personal computer, video game system using a television set (Col. 4 Lines 35-42) with full motion video as taught by Poole into the invention of Loose in order to create greater player entertainment and excitement.

Response to Arguments

10. Applicant's arguments with respect to claims rejected under have been considered but are moot in view of the new ground(s) of rejection. Further, Examiner would like to point out that upon rereading Loose examiner reasonably believes that the support for rejecting the claims under 35 U.S.C. § 102(e) was there all along in the embodiment of Fig. 7 and that Loose is not limited to mechanical reels but also video reels (Col. 4 Line 44). As so, Examiner renews the 102(e) statutory rejections.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is

(571)270-1992. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/Paul A. D'Agostino/
Examiner, Art Unit 3714